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09/416,526	10/12/1999	ERKKO LEHTONEN	367.37732X00	6275

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EXAMINER

TORRES, MARCOS L

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 11/05/2003 *18*

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/416,526

Applicant(s)

LEHTONEN ET AL.

Examiner

Marcos L. Torres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-30 have been considered but are moot in view of the new ground(s) of rejection.

Regarding applicant's arguments that manually dialing is not sensing, one definition of sensing is: **To become aware of; perceive.**<sup>1</sup>, the Sonti system have to become aware or perceive that the user made a selection regarding his configuration, therefore the Sonti system is sensing.

Regarding applicant's arguments to the Friedmann reference, that he is not choosing automatically a configuration. One definition of configuration is **Arrangement of parts or elements.**<sup>2</sup> Friedmann discloses selecting automatically a set of communication parameters (see col. 3, lines 55-56) this set of communication parameters is a configuration; therefore Friedmann discloses the mentioned limitation.

Regarding applicant's argument that Friedmann do not disclose configurations related to the particular subscriber, Friedmann discloses configurations related to the particular subscriber (see col. 5, lines 56-59).

Regarding applicant's argument that Friedmann do not disclose pre-defined criterion definable by the subscriber or a service provider, Friedmann pre-defined

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criterion is definable by a service provider (see fig. 3) and Sonti discloses a pre-defined criterion definable by the subscriber (see col. 6, lines 5-8). The current rejection in record stands.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1- 3, 6, 9-10, 12-14, 18, 20-21 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view of Friedmann and further in view of Vossler.

As to claim 1, Sonti discloses a method of configuring services for a subscriber within a communication system, comprising the step of: reading an external parameter (see column 8, lines 25-29); choosing for the particular subscriber, a configuration of communication services from a plurality of configurations in the communication system (see column 5, lines 32-44); and using the chosen configuration to define a current configuration of communication services available to the subscriber, wherein said choosing of a configuration of communication services is performed in dependence on the sensed external parameter meeting a pre-defined criterion definable by the subscriber (see column 1, lines 57-60). Sonti do not specifically disclose said choosing is sensed automatically. Friedmann discloses configuration choosing is automatically sensed (see col. 3, lines 51-58). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Friedmann teachings with Sonti system for an easier and more reliable system.

As to claims 2 and 3, Sonti discloses a method wherein the plurality of configurations is specific to the subscriber and wherein the pre-defined criterion is dependent upon the subscriber (see column 6, lines 7-11).

As to claim 6, Sonti discloses a method wherein a predetermined configuration of a communication services is designated to be used in the event that no other configurations meet the pre-defined criterion (see column 5, lines 62-65).

As to claim 9, Sonti discloses a method wherein the pluralities of configurations is stored in a central database of the communication system (see column 5, lines 13-15).

As to claim 10, Sonti discloses that his method wherein the configurations are stored central database is a Home Location Register and anticipated that it could be a different system (see column 5, lines 40-41 and column 9, lines 9-14).

As to claims 12 and 13, Sonti discloses a method wherein the sensed external parameter is indicative of a time, the predefined criterion is a time and location dependent criterion and the choosing of the configuration of a communication services is performed in dependence on the sensed external parameter meeting the time or location dependent criterion (see column 1, lines 57-60). Sonti do not specifically disclose said choosing is sensed automatically. Friedmann discloses configuration choosing is automatically sensed (see col. 3, lines 51-58). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Friedmann teachings with Sonti system for an easier and more reliable system.

As to claim 14, Sonti discloses a method wherein the predefined criterion is dependent upon the equipment identity of the mobile station (see column 5, line 65 to column 6, line 1).

As to claim 18, Sonti discloses an apparatus, for use in a communication system, comprising a register of subscribers to the communication system (see column 4, lines

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56-65); a register of alternative configurations of communication services available within communication system (see column 6, lines 31-36); sensing means for sensing an external parameter (see column 1, lines 56-60); means for automatically choosing one of the alternative configurations of communication services available within the communication system for a particular subscriber in response to the sensed external parameter meeting a predefined criterion definable by the particular subscriber (see column 8, lines 25-29; col. 6, lines 5-10); and means for using the chosen configuration of communication services to define a current configuration of communication services available to the particular subscriber (see column 3, lines 12-48).

As to claim 20, Sonti discloses an apparatus wherein the alternative configurations of communication services are specific to the particular subscriber (see column 2, lines 34-42).

As to claim 21, Sonti discloses an apparatus wherein pre-defined criterion is specific to the particular subscriber (see column 1, lines 56-60).

As to claims 26 and 27, Sonti discloses an apparatus in a communication system comprising: sensing means for sensing at least one external parameter; register means for storing predefined criteria for a mobile station (see col. 8, lines 25-29). Sonti do not specifically disclose processing means for automatically choosing a configuration for the mobile station available within the communication system and related to the mobile station based on the sensed at least one external parameter meeting the predefined criterion. Friedmann discloses processing means for automatically choosing a configuration for the mobile station available within the communication system and

related to the mobile station based on the sensed at least one external parameter meeting the predefined criterion (see col. 3, lines 51-58). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Friedmann teachings with Sonti system for an easier and more reliable system.

5. Claims 4-5, 7-8, 11, 15-17, 19, 23-25 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view of Friedmann as applied to claims 1- 3, 6, 9-10, 12-14, 18, 20-21 and 26-27 above, and further in view of Buhrmann ('778).

As to claim 4, Sonti discloses everything claimed as explained above except for a method wherein the choosing of a configuration of communication services is performed each time a call is made. Buhrmann discloses a method wherein the choosing of a configuration of communication services is performed each time a call is made (see column 11, lines 9-19). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add these features to the modified Sonti system for a more versatile system.

As to claim 5, Sonti discloses everything claimed as explained above except for a method wherein the plurality of configurations is ranked in order of priority such that one of relatively higher priority that satisfies the predefined criterion is used before one of relatively lower priority that also satisfies the predefined criterion. Buhrmann discloses a method wherein the plurality of configurations is ranked in order of priority such that one of relatively higher priority that satisfies the predefined criterion is used before one of relatively lower priority that also satisfies the criterion (see column 8, lines 20-38).



Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the Buhrmann features to the modified Sonti system for the simple purpose of increasing the flexibility of the system.

As to claim 7, Sonti do not specifically disclose a method wherein the automatic choosing of a configuration of communication services may be overridden to allow selection or registration of a particular registration configuration. However the use of manually override an automatic process is a common and well known technique, for example stopping a voice mail system, silence an incoming call, etc. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the modified Sonti system for more convenience.

As to claim 8, Sonti do not specifically disclose a method wherein selection or registration of a certain configuration is not permitted according to a predefined rule. However, denial of a service or features when they are not valid in predefined rule is a common and well-known technique. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this feature to the modified Sonti system to minimize errors.

As to claims 11, 25 and 30, Sonti discloses everything claimed as explained above except for the method wherein the sensed external parameter is indicative of date, the predefined criterion is a date-dependent criterion and the choosing of a configuration of communication services is performed automatically in dependence on the sensed external parameter meeting the date-dependent criterion. ). Friedmann discloses processing means for automatically choosing a configuration for the mobile

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station available within the communication system (see col. 3, lines 51-58). Buhrmann discloses a method wherein the predefined criterion is dependent upon the date (see column 6, lines 32-42). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine these techniques to further automate the modified Sonti system.

As to claim 15 and 16, Sonti discloses everything claimed as explained above except for the method wherein the predefined criterion is dependent upon the number or type called. 15. Buhrmann discloses a method wherein the predefined criterion is dependent upon the number or type called (see column 8, lines 25-31). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the feature of Buhrmann to the modified system of Sonti for a more versatile system.

As to claim 17, Sonti discloses everything claimed as explained above except for a method wherein a configuration of the communication service is chosen automatically according to a plurality of predefined criteria. Buhrmann discloses a method wherein a configuration is chosen according to a plurality of predefined criteria (see column 8, lines 5-19). Friedmann discloses processing means for automatically choosing a configuration for the mobile station available within the communication system (see col. 3, lines 51-58). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the feature of Buhrmann to the modified system of Sonti for an easier updating system.

As to claim 19, Sonti discloses an apparatus wherein said registers form part of the Home Location Register (HLR). Sonti do not specifically disclose the use of his system in a GSM communication system. However, it would be obvious to one of the ordinary skill in the art at the time of the invention to use the modified Sonti system in an equivalent communication system.

As to claim 23, Sonti discloses everything claimed as explained above except for an apparatus or method wherein the external parameter is a hardware parameter. Buhrmann discloses an apparatus or method wherein the external parameter is a hardware parameter (see column 6, lines 43-59). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add a hardware parameter to the modified Sonti system for more enhanced functions.

As to claim 24, Sonti discloses a communication system comprising: a Mobile Services Switching Center (MSC) (see fig. 1, #34), the MSC including a Home Location Register (HLR) (see col. 5, lines 13-14, fig 1, #74); a base station controller operatively connected to the MSC; a base station operatively connected to the base station controller (see fig. 1, #40); and a mobile station operatively connected to the base station (see fig. 1, #30), the mobile station having capability for sensing at least one external parameter, a configuration of communication services for the mobile station being chosen from a plurality of configurations available within the communication system and related to the mobile station based on the sensed external parameter meeting a pre-defined criterion definable at the mobile (see col. 8, lines 25-29). Sonti do not disclose that the configuration is automatically chosen. Friedman discloses that the

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configuration is automatically chosen (see col. 3, lines 51-58). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine the Friedmann teachings with Sonti system for an easier and more reliable system.

As to claims 28 and 29, Sonti discloses everything claimed as explained above except for the method wherein the plurality of individual service arrangements further comprise at least one of speech services, SMS messaging, international calls barred, international calls barred except to home country, data transfer rate, fax services, High Speed Circuit Switched Data (HSCSD), General Packet Radio Services (GPRS), and outgoing calls barred. Sonti discloses the method wherein the plurality of individual service arrangements further comprise at least one of speech services, SMS messaging, international calls barred, international calls barred except to home country, data transfer rate, fax services, High Speed Circuit Switched Data (HSCSD), General Packet Radio Services (GPRS), and outgoing calls barred (see col. 11, lines 34-54). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add these features to the modified Sonti system for enhanced multiple services.

6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sonti in view Friedmann as applied to claims 1- 3, 6, 9-10, 12-14, 18, 20-21 and 26-27 above, and further in view of Hagar.

As to claim 22, Sonti discloses everything claimed as explained above except for the apparatus wherein the external parameter is an environmental parameter. Hagar discloses an telecommunication apparatus wherein the external parameter is an

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environmental parameter (see col. 1, lines 5-14). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add the Hagar teachings to the modified Sonti system for an enhanced multi feature communication system.

***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L Torres whose telephone number is 703-305-1478. The examiner can normally be reached on 8:00am-5:30pm alt. friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William G Trost can be reached on 703-305-5318. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

Marcos L Torres  
Examiner  
Art Unit 2683

Mlt



**WILLIAM TROST**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**